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10/719,768	11/21/2003	Susanta Datta	847-073	3283
20874 7590 03/01/2007 MARJAMA & BILINSKI LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202			EXAMINER TAMAI, KARL I	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/719,768
Filing Date: November 21, 2003
Appellant: DATTA, SUSANTA

Joseph B. Milstein

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/01/2006 appealing from the Office action mailed 6/22/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

<u>Patent Number</u>	<u>Inventor</u>	<u>Publication Date</u>
3750951	Perl	August 7, 1973

PUBLISHED ARTICLE:

Selders "Electric Motors - Lubrication and Cleaning"

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Perl (US 3750951). Perl teaches an unsealed, open motor for a dishwasher which include the steps of inserting a washing fluid into the motor (inherently washing the motor), removing the fluid, and operating the motor after draining (inherently drying and protecting against failure) (col. 5, line 40).

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perl (US 3750951) and Selders (Electric Motors – Lubrication and Cleaning). Perl teaches every aspect of the invention except periodically removing the motor to be cleaned. Selders teaches disassembly of the motorized device to provide a through cleaning. It is would have been obvious to a person of ordinary skill in the art at the time of the invention to remove the motor from the apparatus prior to cleaning to clean foreign matter from the motor, as taught by Selders.

(10) Response to Argument

- 35 USC 102(b) over Perl

Appellant's argument that Perl does not teach a non-corrosive housing is not persuasive. In the first embodiment Perl teaches the motor includes an epoxy-potting compound, which is inherently non-corrosive. In the second embodiment Perl teaches the motor includes a non-magnetic, stainless steel housing 64, which is inherently non-corrosive. Appellant's argument that Perl's stainless steel housing is not inherently non-corrosive is not persuasive because Appellant admits that stainless steel is non-corrosive (see paragraph 0006, lines 8). Appellant's argument that Perl does not teach cleaning the motor is not persuasive. It is inherent that the motor is washed while washing the dishes because the washing water is flowing through the motor. Appellant's argument regarding drying of the motor is not persuasive. Perl clearly teaches that the motor is evacuated of water and then the air is heated by energizing the motor (col. 5, line 40), which will inherently dry the motor.

Appellant argued that the motor of Perl must be perfectly cleaned in order to read on the claim 10. The examiner disagrees. "Cleaned" as set forth in the CLAIMS merely permitting washing fluid to enter an unsealed motor, removing the water, and operating the motor to remove residual washing fluid. Perl discloses these steps. Appellant's argument that the examiners position lacks proof or is a conclusory statement is not persuasive. The examiner is not basing the rejection on based on Official notice or personal experience. Perl teaches the claimed steps of claim 10 and 11. Perl is the evidence. Appellant may have a different definition of "washed" or "cleaned", but the claim does not reflect the applicant's definition or the degree of cleanliness. The examiners position is supported by case in that the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Appellant's arguments regarding residual material from dishes or permanently fouled residue on the motor is not persuasive because the limitation is not claimed. The claim only requires washing fluid to go in and be removed from the motor, not some or all of dirt, grease, oil, dust, contaminants that may be within the motor.

Appellant's argument regarding the Perl's teaching of drying (col.5, line 40) is not persuasive. Perl teaches the exact same steps as the Appellant's claims, those being permitting washing fluid to enter an unsealed motor, removing the washing fluid (col. 5, line 39: evacuating the water), and operating the motor (col. 5, line 40: energizing with motor) to remove residual water. Perl teaches the heat of the motor assisting in the drying of dishes. The heat from the motor which is drying dishes in a separate

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compartment of the dishwasher, is must also dry any residual washing fluid with is in direct contact with the motor parts. The Appellant cannot rationally make the argument that there is no residual washing fluid when it the housing is evacuated or that the washing fluid is not removed by operating the motor, but the specification and claims are direct admission by the Appellant (page 20, line 8). Appellant's arguments regarding inherency are not persuasive because they are contrary to the Appellant's admission in the specification and claims, as set forth above.

Appellant's arguments regarding hindsight are not persuasive because Perl teaches all of the Appellant's claimed washing steps. There is no hindsight reconstruction that pieces together several references using the Appellant's disclosure as a guide. Perl teaches the steps claimed by the Appellant. Perl permitting washing fluid to enter an unsealed motor, removing the water, and operating the motor thereafter. Appellant's argument that there is no visual or textual argument in Perl is not persuasive. The steps are taught as set forth above, particularly col. 5, lines 39-40. Appellant's argument regarding a product by process is not persuasive because the "method" steps set forth in the Appellant's claims are disclosed as method steps in Perl.

- PREAMBLE-

Appellant's argument that the preamble be give patentable weight regarding the FDA oversight is not persuasive. The statement both clearly in the preamble and not the body of the claim, AND clearly a statement of intended use. Particularly the preamble recites :

10. "A method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight"

The preamble does not provide any structure or method steps to the claim, only a statement of intended use. Particularly, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here the process steps do not refer back to FDA oversight nor does the structure rely on food or drug preparation or FDA oversight, therefore limitation is clearly not given patentable weight. Additionally, *Ex Parte Masham*, 2 USPQ2d. 1647 (1987) holds that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the apparatus from the prior art apparatus. Therefore the intended use of the apparatus is not relevant to the claimed method of cleaning a motor. Appellant's argument that the intended use of the motor breaths life and meaning into the claims is not persuasive because there are no claim limitations in the body of the claim that refers back to intended use of the motor after the claimed steps are performed. Appellant's arguments regarding FDA regulation are not persuasive because they are NOT claimed.

The Appellant's arguments regarding food and medicine preparation are not persuasive because, even if the limitation were given patentable weight, Perl meets the limitation since it teaches a dishwasher. Dishwashers are used in the preparation of

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food, which is subject to FDA oversight. The examiner notes that if the recitation were somehow construed to be a physical limitation recited by the claim, then the limitation would have to be considered indefinite because the types of motors which would be subject to FDA oversight periodically changes at the whim of Congress and the Food and Drug Administration.

-103(a) rejection of Claim 12-

Appellant's argument that Selders teaches disassembling the motor, which is different that removing the motor from an apparatus prior to cleaning is not persuasive. Selders clearly teaches disassembling the motor including 12 steps to thoroughly clean the motor. The 12 steps cannot be done while the motor is attached to a driven apparatus. It is absolutely inherent that during disassembly of the motor, it is removed in part or whole, the driven apparatus. Particularly, the endshield and rotor cannot be unbolted and removed if the motor is still attached to the driven device (step 3). All or part of the motor must be removed from the driven apparatus, therefore it is inherent.

Appellant's argument that there is no motivation to combine the references is not persuasive. Selders literally teaches the motivation of removing foreign matter and dirt that accumulates in the motor. Applicant's arguments regarding hindsight are not persuasive because the references themselves provide literal motivation, not the Applicant's disclosure. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) holding that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

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invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In the instant application the motivation is taken literally from Selders, to any dirt or foreign matter which may accumulate in the motor and cause overheating or trouble in the motor(see page 2, paragraph 3).

Appellant's argument regarding the motivation to clean Perl when Perl inherently teaches cleaning is not persuasive. Selders teaches a thorough cleaning and routine maintenance on the bearings which can only be achieved by disassembling the motor and removing the motor from the driven device (page 2, paragraph 3). Applicant's argument that removing the rotor and the end shield from the motor is not removing the motor from the apparatus is not persuasive because the rotor of Perl cannot be removed unless the stator with the resin housing 44 or the stator with the stainless steel housing 64 is removed from the dishwasher. Selders clearly and literally teaches the disassembly of the motor for cleaning and Perl would need to be removed from the tub 10 in order to be cleaned and achieve the benefits of the removal of dirt and foreign matter which enters into the motor as taught by Selders.

Appellant's arguments regarding the time between cleaning and the types of bearings are not persuasive because the limitations are not claimed. Applicant's arguments regarding SAE oil is not persuasive because the Selders only teaches in general the oil is SAE oil, not that it has to be SAE oil. The type of oil or the type of bearing is NOT claimed. The references are consistent because Perl teaches that the bearings 50 are sealed (bottom of col. 3) and Selders that care must be taken with sealed bearing during cleaning (page 2, #7) not to allow a solvent to enter the bearing.

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The combined teaching of the references teaches cleaning the motor or Perl to remove dirt and foreign matter, but do it with care when handling the bearings.

Appellant's argument regarding Selders being used with FDA oversight is not persuasive because the limitation is not claimed. The recitation is both in the preamble with no structural connection to the body of the claim AND it is clearly set forth as an intended use recitation which does not further limit the body of the claim. Even if it were misconstrued to be part of the claim, the combined teaching of Selders and Perl teach a dishwasher which is used in food preparation and subject to FDA oversight.

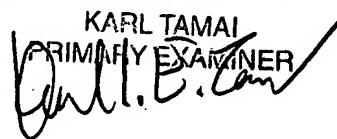
The rejection is proper and should be maintained.

(11) Related Proceeding Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KARL TAMAI
PRIMARY EXAMINER


Karl I.E. Tamai

Primary Patent Examiner – AU 2834

Conferees: 02/21/2007

Karl I.E. Tamai – Primary Patent Examiner – AU 2834 

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